

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO. 68	FILING DATE 09/13/99	FIRST NAMED INVENTOR VANDEVORDE	ATTORNEY DOCKET NO.
09444968			P AC02587P1US

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IM22/0913

EXAMINER

BAGWELL, M

ART UNIT	PAPER NUMBER
1711	6

DATE MAILED: 09/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/444,968	VANDEVOORDE ET AL.
	Examiner Melanie D. Bagwell	Art Unit 1711
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). 		
Status		
<p>1)<input type="checkbox"/> Responsive to communication(s) filed on _____.</p> <p>2a)<input type="checkbox"/> This action is FINAL. 2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
Disposition of Claims		
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-17</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) <u>7-11 and 13-17</u> is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-6 and 12</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
Application Papers		
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
Priority under 35 U.S.C. § 119		
<p>13)<input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a)<input type="checkbox"/> All b)<input checked="" type="checkbox"/> Some * c)<input type="checkbox"/> None of the CERTIFIED copies of the priority documents have been:</p> <p>1.<input checked="" type="checkbox"/> received.</p> <p>2.<input type="checkbox"/> received in Application No. (Series Code / Serial Number) _____.</p> <p>3.<input type="checkbox"/> received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>* See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14)<input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).</p>		
Attachment(s)		
<p>15)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>16)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>17)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u>.</p> <p>18)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</p> <p>19)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>20)<input type="checkbox"/> Other: _____</p>		

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6 and 12, drawn to a coating composition, classified in class 525, subclass 127+.
 - II. Claims 7-11 and 13-17, drawn to a method of coating and coated substrate, classified in class 428, subclass 423.1.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful in making self-supporting molded articles and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Richard Frennally on July 27, 2000 a provisional election was made with traverse to prosecute the invention of I, claims 1-6 and 12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11 and 13-17 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho.

8. Claims 1-2, 4-6, and 12 are drawn to a coating composition having a film forming polyol solid resin, a polyisocyanate, and a specific diol. Ho discloses a composition to be used as a clearcoat (col. 24 lines 26-28) comprising 2-butyl-2-ethyl-1,3-propanediol, an isocyanate, and two polyol compounds (ex. 8 cols. 29-30 and 38). The coating composition combines the polyurethane formed from these ingredients with solvents, such as methyl ethyl ketone, and a urethane dispersion to form a coating dispersion; Ho

shows use of a polyurethane derived from the specific diol but does not exemplify a coating composition with the unreacted components present. It is the examiner's position that it would have been *prima facie* obvious at the time of the invention to leave the components in the unreacted form as a matter of design to increase the shelf life of the coating.

9. Claim 3 limits the solid resin to an polyacrylate polyol. The example presented by Ho does not teach the use of an acrylic polymer; however, Ho notes the possible addition of a polyacrylate polyol to the coating composition to improve gloss retention and decrease drying time of the coating (col. 16 lines 18-34). Therefore, it would have been *prima facie* obvious to include an acrylate polyol in the exemplified coating composition to improve gloss retention of the coating.

Priority

10. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 5/21/97. It is noted, however, that applicant has not filed a certified copy of European Patent Application No. 970201511.9 as required by 35 U.S.C. 119(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bagwell whose telephone number is (703)308-6539. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703)308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)872-9309.

mdb

September 8, 2000


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700